



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Michael KRIEGER

Application No.: 10/731,113

Filed: December 10, 2003

For: LANTERN WITH INTERNAL
CONVERTER CIRCUIT

Confirmation No.: 4513

Art Unit: 2875

Examiner: Ismael NEGRON

Atty. Docket No.: 32405.199591

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PATENT TRADEMARK OFFICE

APPEAL BRIEF

Mail Stop: *Appeal Brief - Patents*
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Sir:

In furtherance of the Notice of Appeal and a Pre-Appeal Brief Request filed on July 17, 2006, the Appellant submits herewith an Appeal Brief in accordance with 37 C.F.R. § 41.37.

The fees required under § 41.20(b)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

VENABLE LLP
P.O. Box 34385
Washington, DC 20043-9998
Telephone: (202) 344-4000
Telefax: (202) 344-8300
Attorneys/Agents for Applicant-Appellant

11/20/2006 SZEWDIE1 00000124 220261 10731113

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¹ The Table of Contents is included for reference purposes only and not to limit the issues to be reviewed on appeal.

Application No.: 10/731,113
Michael KRIEGER

I. REAL PARTY IN INTEREST – 37 C.F.R. § 41.37(c)(1)(i)

The real party in interest for this appeal is:

Black & Decker Inc.
1207 Drummond Plaza
Newark, Delaware 19711

The aforementioned real party is a successor in interest to Vector Products, Inc., which is the assignee of the present application by virtue of assignment from the inventor, Michael Krieger, recorded April 23, 2004, at Reel 015261, Frame 0315.

**II. STATEMENT OF RELATED APPEALS AND INTERFERENCES – 37 C.F.R. §
41.37(c)(1)(ii)**

There are no other appeals, interferences or judicial proceedings known to the Appellant, Appellant's legal representatives, or the above-noted inventor/assignor, that will directly affect or will be directly affected by or have bearing on the Board's decision in this appeal.

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III. STATUS OF CLAIMS – 37 C.F.R. § 41.37(c)(1)(iii)

Pending claims 14, 16-22, 25 and 27-36 were rejected in the Final Office Action dated March 17, 2006. Pending claims 14, 16-22, 25 and 27-36 are hereby appealed.

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IV. STATUS OF AMENDMENTS – 37 C.F.R. § 41.37(c)(1)(iv)

An Amendment after Final Rejection was filed on June 8, 2006 in response to Final Office Action dated March 17, 2006. The proposed amendments were not entered according to the Advisory Action dated June 26, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER – 37 C.F.R. § 41.37(c)(1)(v)

A. Features of the Invention

The present invention provides a portable rechargeable electric lantern that is easy to recharge and easy to position for optimum light placement. The lantern includes a first housing, a rechargeable power supply disposed in said first housing, and a light source coupled to the rechargeable power supply. An AC-to-DC converter is disposed within a second housing and includes an AC connector arranged for being connected to an external power cord for delivering AC power to the AC-to-DC converter. The AC-to-DC converter is coupled to the rechargeable power supply and converts the AC power to a DC output for recharging the rechargeable power supply.

The second housing enclosing the AC-to-DC converter is substantially enclosed by the first housing. The second housing isolates the AC-to-DC converter circuitry from the rest of the lantern, therefore allowing the AC-to-DC converter unit to be rated by the Underwriters Laboratories (UL) independently of the rest of the lantern. This feature provides an advantage over the prior art, wherein the entire lantern or light source would have to be rated by the Underwriters Laboratories and, hence, the entire lantern or light source would have to comply with the applicable UL standards. The present invention allows the lantern or light source to meet the applicable UL standards without the need for the entire lantern or light source to be rated.

B. The Independent Claims on Appeal – Claims 14 and 25

The following explanation of the claimed subject matter, with reference to the specification and drawings of the instant application, is by way of example and for explanation only. The invention is not limited to the disclosed embodiments, and certain elements may be found in more than one of the disclosed embodiments.

Claim 14

Claim 14 recites a portable rechargeable electric light 102 as depicted in FIGS. 1 and 2. The portable rechargeable electric light comprises a first housing, which includes the base 108 shown in FIG. 1. As recited in claim 1, a rechargeable power supply 130 is disposed in the first housing. Please see FIG. 4 and page 6, first full paragraph. The rechargeable power supply 130 is coupled to a light source 112 to provide DC power to the light source, as shown

in FIGS. 1 and 2 and discussed in page 4, first full paragraph. The rechargeable electric light 102 also comprises an AC-to-DC converter 144. The AC-to-DC converter 144, as recited in claim 1, includes an AC connector 142 arranged for being connected to an external power cord (e.g. a household extension cord, the opposite end of which has a plug adapted to be plugged into a typical wall outlet) for delivering AC power to the AC-to-DC converter 144. The AC-to-DC converter 144 converts the AC power to a DC output for recharging the rechargeable power supply 130 and is disposed in a second housing. The second housing itself is substantially enclosed by the first housing. Please see page 7, third paragraph, continuing on page 8. As such, the second housing isolates the AC-to-DC converter 144 from the rest of the rechargeable electric light 102.

Claim 25

Claim 25 recites a rechargeable light source 112 as depicted in FIGS. 1 and 2. The rechargeable light source 112 comprises a first housing defining a cavity therein. As discussed in page 6, first full paragraph, the first housing includes a base 108 and the cavity is located within the base 108. As recited in claim 25, a rechargeable power supply 130 is disposed in the cavity. Please see page 6, first full paragraph. A light source 112 is selectively coupled to the rechargeable power supply 130. Please see FIGS. 1 and 2, and page 4, first full paragraph. There is also an AC-to-DC adapter that is connected to the rechargeable power supply 130 to provide power. The AC-to-DC adapter includes a second housing that contains the AC-to-DC converter circuitry. The AC-to-DC adapter may, for example, be a wall cube, and is arranged within the cavity such that the second housing is substantially enclosed by the first housing. Please see FIG. 5 and page 7, last paragraph, continuing on page 8 (explaining that AC-to-DC adapter is substantially enclosed by a second housing that encloses the adapter circuitry ... the adapter is also arranged within an exterior housing, such as base 108). As such, the AC-to-DC adapter constitutes a unit separate and distinct from the rest of the rechargeable light source 122.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL – 37 C.F.R. §
41.37(c)(1)(vi)**

A. Whether the Examiner has established that claim 34 is unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

B. Whether the Examiner has established that claims 25 and 27 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,628,339 to Werner (“Werner”).

C. Whether the Examiner has established that claims 14, 16-19, and 28-29 are unpatentable under 35 U.S.C. § 103(a) over Werner.

D. Whether the Examiner has established that claims 20-22, 30 and 33-36 are unpatentable under 35 U.S.C. § 103(a) over Werner in view of U.S. Patent No. 6,260,985 to Zeller (“Zeller”).

E. Whether the Examiner has established that claims 31 and 32 are unpatentable under 35 U.S.C. § 103(a) over Werner in view of Zeller, and further in view of U.S. Patent No. 6,789,924 to Yuen (“Yuen”).

VII. ARGUMENT – 37 C.F.R. §41.37(c)(1)(vii)

A. The Rejection of Claim 34 Under 35 U.S.C. § 112, Second Paragraph

On page 2 of the Office Action dated March 17, 2006, claim 34 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Action points out that claim 34 “is indefinite as it is not clear on what housing is the second light source disposed on, as two different housings were previously claimed.”

In the Amendment after Final Rejection filed on June 8, 2006, the Appellant amended claim 34 to recite as follows:

The light source of claim 25, further comprising a second light source disposed on the first housing.

In the Advisory Action before the Filing of an Appeal Brief dated June 26, 2006, however, the proposed amendment was not entered because it was not “deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.” Further, the Advisory Action does not address the Appellant’s argument regarding this rejection. It is believed that claim 34, as amended, overcomes the Examiner’s rejection under 35 U.S.C. § 112, second paragraph. Accordingly, Appellant respectfully requests that the amendment to claim 34 be entered and the Examiner’s rejection of this claim be reversed.

B. The Rejection of Claims 25 and 27 Under 35 U.S.C. § 102(b)

On pages 3 and 4 of the Office Action, claims 25 and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,628,339 to Werner (“Werner”). The Appellant respectfully traverses these rejections and hereby appeals the same.

A claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *MPEP 2131* citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Further, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *MPEP § 2131.02* citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, even within a single reference, separate portions of that reference cannot be properly combined in the absence of “particular findings...as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected [those portions] for combination in the manner claimed.” *In re Kotzab*,

217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Appellant respectfully submits that Werner does not teach or suggest each and every element of claims 25 and 27. Claim 25 recites in part “an AC-to-DC adapter including a second housing containing converter circuitry … the second housing [being] substantially enclosed by the first housing.” This feature is neither taught nor suggested by Werner. Accordingly, the cited reference Werner fails to anticipate the present claim under 35 U.S.C. § 102(b).

Werner discloses a portable flashlight with storage battery and rectifier. The flashlight comprises a container section 11 that forms the body of the flashlight, a transformer 80 for reducing the voltage, a rectifier unit 81 for converting alternating current (AC) into direct current (DC), a battery (including electrodes 44 and 46 and the accompanying circuitry), and a light source 16. See FIG. 1. The male contacts 79 of a plug connection provide AC current to the transformer 80, which is itself connected to the rectifier unit 81. Col. 4: 56-59. The rectifier unit 81 delivers DC power to the battery unit. See FIG. 1. There is no element of Werner that teaches or discloses a “second housing containing converter circuitry” that is “substantially enclosed by the first housing.”

As shown in FIG. 5, an embodiment of the present application comprises a first housing, such as base 108. A rear of the base 108 defines a cavity 140. An AC-to-DC adapter 144, which converts the AC input into DC power for recharging the power supply, includes a second housing which encloses the converter circuitry. The AC-to-DC adapter, as recited in claim 25, refers to the AC-to-DC converter circuitry enclosed within the second housing. As such, the AC-to-DC adapter 144 may be a standard wall cube, wherein the second housing is the outer shell of the wall cube enclosing the AC-to-DC converter circuitry. The AC-to-DC converter circuitry may comprise discrete circuit components arranged on a printed circuit board, each of which may have their own packaging. For example, the AC-to-DC converter circuitry may include a transformer and a rectifier, each of which is packaged as a discrete component. Alternatively, the components of the AC-to-DC converter circuitry may be packaged together on a single chip (e.g. System-on-a-Chip). No matter how the AC-to-DC converter is designed, however, the entire AC-to-DC converter circuitry is enclosed by the second housing. The AC-to-DC adapter 144, as recited in claim 25, is the entirety of the AC-to-DC converter circuitry being contained within a second housing. The second housing is then substantially enclosed by the first housing, base 108.

Such arrangement allows the lantern to meet applicable standards for power units due to the construction of the second housing, without the rest of the base 108 having to meet the standards.²

In the Office Action dated March 17, 2006, the Examiner argues that the rectifier unit 81 of reference Werner teaches or suggests the second housing containing converter circuitry. Such construction of the “second housing” is, however, unfounded, because the rectifier unit 81 is a component of the AC-to-DC converter and cannot be construed as a “housing” enclosing the AC-to-DC converter. As depicted in FIG. 1 of Werner, the transformer 80 and the rectifier unit 81 are individual circuit components that are part of the AC-to-DC converter. The components are enclosed by a charging container 75. See FIG. 1. However, the charging container 75 is not itself enclosed within any other housing. Therefore, neither the charging container 75, nor the discrete circuit components 80 and 81 that form the AC-to-DC converter of Werner, correspond to the claimed second housing.

In the Advisory Action dated June 26, 2006, the Examiner once again states that the rectifier unit 81 of Werner anticipates the second housing containing converter circuitry of the present invention. In pages 3-4 of the Advisory Action, the Examiner argues that the language of claim 25 merely recites the converter circuitry, not the whole of the AC-to-DC adapter, to be contained within the second housing, such second housing being substantially enclosed by the first housing. Accordingly, the Examiner argues, the AC-to-DC adaptor is not required by the language of the claims to be contained by the second housing. The Examiner concludes:

WERNER, as detailed in previous Section 5, clearly discloses a flashlight including a first housing (combination of elements 11, 14 and 75), such first housing enclosing an AC-to-DC adapter formed by transformer 80 and converter circuitry 81 (as admitted by the applicant), such transformer and rectifier circuitry being contained in separate enclosures (as seen in Figure 1). The converter circuit housing (i.e. the second housing) is substantially enclosed by the first housing. While it is true that part of the AC-to-DC adapter (i.e. the transformer 80) is not contained by the second housing, Claim 25 does not require it to be (as opposed to Claim 14 which defines the complete AC-to-DC converter as contained within the second housing).

The Appellant respectfully disagrees with the Examiner’s characterization of Werner and the claimed invention for several reasons.

On page 3 of the Advisory Action, the Examiner purportedly relies on *In re American*

² Such standards include UL 1310 standard for power units and UL 94 V1 standard for fire rating. See Specification: page 7, line 13 to page 8, line 9.

Academy of Science Tech Center, 70 USPQ2d 1827 (Fed. Cir. 2004) to assert that “while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims … during examination, the claims must be interpreted as broadly as their terms reasonably allow.” However, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), the Court established standards for claim construction during the course of examination. In that case, the Court stated that the USPTO must determine the scope of claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.” *Id. at 1316*. This standard was later applied by the Court in *In re Johnston*, 435 F.3d 1381, 77 U.S.P.Q.2d 1788 (Fed. Cir. 2006), in which although the Court affirmed the B.P.A.I.’s use of a dictionary in interpreting terms of the applicant’s claims, it did so because the specification did not otherwise provide any limitations on the terms.³

Applying the *Phillips* standard to present invention, it is clear that the Examiner’s interpretation of the claim 25 is inconsistent with the description of a “second housing” according to the Specification.⁴ On pages 7-8 of the Specification, the “second housing” is described as enclosing the AC-to-DC converter. The description states that the AC-to-DC converter circuit is substantially enclosed by two housings: one such housing being the housing 144 that encloses all the circuitry of the converter and another housing being the housing for the lantern or the light source. Claim 25 recites “an AC-to-DC adapter including a second housing containing converter circuitry.” As such, the AC-to-DC adapter is a unit that has a housing (i.e. the second housing) containing the converter circuitry. The AC-to-DC adapter may be a wall cube or a similar device that contains all the converter circuitry within a housing. It would be unreasonable to argue that the housing may contain only some of the converter circuitry. Therefore, it would be unreasonable to interpret the second housing as enclosing only some of the converter circuitry and not the rest. Accordingly, in

³ The Court stated: “dictionary definitions must give way to the meaning imparted by the specification.”

⁴ The Applicant recognizes that although the Examiner must read the claim in light of the Specification, such reading is limited to understanding the claim language. “Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ 1865, 1868 (Fed. Cir. 2004). The Appellant does not urge reading any limitations from the Specification into the language of claim 25. However, the meaning of “second housing”, according to claim 25, must be construed in light of the Specification.

Accordingly, in light of the written description, the “second housing”, as recited in claim 25, should not be interpreted as equivalent to a rectifier unit, which is a component of the AC-to-DC converter. The Examiner’s statement that “the language of claim 25 merely recites the converter circuitry, not the whole of the AC-to-DC adapter, to be contained within the second housing” is an unreasonable interpretation of claim 25, in light of the written description.

Even if claim 25 is to be interpreted without reference to the written description, the interpretation set forth by the Examiner is still unreasonably broad. A person of ordinary skill in the art would understand that “an AC-to-DC adapter including a second housing containing converter circuitry” cannot be reasonably anticipated by the Werner’s rectifier unit 81 of the AC-to-DC converter. The adoption of terms “first housing” and “second housing” makes clear that the second housing refers to a discrete object that encloses all of the AC-to-DC circuitry, including the transformer and the rectifier. In such manner, the AC-to-DC circuitry and components are treated as one unit that is placed within the cavity of the first housing, being separated from the rest of the lantern or other light source.

For the reasons stated above, the Appellant requests that the rejection of claim 25 under 35 U.S.C. § 102(b) be reversed. Claim 27 is dependent on claim 25 and should be allowed for at least the same reasons. Accordingly, reversal of the rejection of claim 27 is similarly requested.

C. The Rejection of Claims 14, 16-19, and 28-29 Under 35 U.S.C. § 103(a)

The Office Action rejects claims 14, 16-19, and 28-29 under 35 U.S.C. § 103(a)⁵ as being unpatentable over U.S. Patent No. 2,628,339 to Werner (“Werner”). The Applicant respectfully traverses the rejections, and hereby appeals the same.

Claims 14 and 16-17

Independent Claim 14 recites in part: “an AC-to-DC converter disposed within a second housing ... and the second housing being substantially enclosed by the first housing.” The Office Action states that Werner teaches all limitations of claim 14, except the AC-to-DC converter being disposed within a second housing. The Action then states that it would have been obvious to one of ordinary skill in the art at the time of the invention to dispose the AC-to-DC converter of Werner within a single housing. The Applicant respectfully

⁵ Claims 14 and 16-19 are rejected on pages 4-7 of the Office Action and claims 28-29 are rejected on page 9 of the Office Action.

traverses, and hereby appeals, the rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See M.P.E.P. § 2143.*

It is respectfully submitted that modifying Werner, as suggested by the Examiner, would not teach each and every element of claim 14. The Action has once again relied on an unreasonably broad construction of “the second housing” in order to make a rejection based on the prior art. Disposing the AC-to-DC converter of Werner into a single unit does not teach the second housing of the present claim, because such second housing is a distinct and separate component of the present invention enclosing all other components of the AC-to-DC converter. Combining the transformer 80 and the rectifier unit 81 into a single component, such as a System of a Chip (SoC) device, would still not suggest or teach a second housing according to the present invention, where such second housing is substantially enclosed by the first housing.

The Advisory Action states: “forming the AC-to-DC converter second and third housing into a single housing would have flown naturally to one of ordinary skill in the art.” To make this assertion, the Examiner relies on *In re Larson*, 144 USPQ 347, 349 (CCPA 1965), stating, “forming in one piece a structure which has formerly been formed in two, or more pieces, involves only routine skill in the art.” The Examiner’s reliance on *In re Larson* is, however, misguided. In *In re Larson*, a claim to a fluid transporting vehicle comprising a brake drum integral with a clamping means was rejected by the PTO where a prior art reference comprised the brake disc and clamp rigidly secured together as a single unit. The court affirmed the rejection holding that “the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.” In the present case, however, the difference between the claimed invention and the disclosure of Werner is not the mere combination of the transformer 80 with the rectifier unit 81. Werner’s transformer 80 and rectifier unit 81 do not constitute separate housings, but are mere components of the AC-to-DC converter. The present invention, on the other hand, includes a second housing, separate and distinct from any of the AC-to-DC converter

components, that is used to enclose the AC-to-DC converter and all the components therein. The second housing is itself substantially enclosed by a first housing, such as the base 108. Such arrangement allows for the AC-to-DC converter to be separate and independent from the rest of the lantern. The second housing enabling such separation is not taught or suggested by Werner or modifications thereto, as suggested by the Examiner.⁶

Furthermore, there is no suggestion or motivation in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify Werner to place its AC-to-DC components within a second housing. The Examiner states in the Advisory Action that “forming the AC-to-DC converter second and third housings into a single housing would have flown naturally to one or ordinary skill in the art to reduce costs and simplify the assembly of the patented illumination device of WERNER.” However, there is no evidence that such modification simplifies or reduces the cost of the assembly of Werner’s device. In fact, for a flashlight according to Werner, such second housing would have been more expensive to implement, because it would require an additional housing between the components of the AC-to-DC converter and the charging container 75. Furthermore, implementing the additional housing in Werner would be futile, since there it would add no value or functionality of the device of Werner.

The second housing in the present invention allows the lantern to meet the applicable UL standards without the need for the entire lantern to meet the UL standards. In other words, the second housing can be rated by the Underwriters Laboratories without the need for the entire lantern to be rated.⁷ Such motivation is not provided in Werner or the knowledge generally available to one of ordinary skill in the art at the time of the present invention.

For at least the reasons stated above, the Applicant respectfully requests that the rejection of claim 14 under 35 U.S.C. § 103(a) be reversed. Claims 16 and 17 are dependent on claim 14 and are submitted as allowable for at least the same reasons. Additionally, claim 17 recites: “The portable light of claim 14, wherein the AC-to-DC converter circuit and prongs comprises a wall cube.” Such feature is neither taught nor suggested by Werner, and the Office Action does not show that this feature would have been obvious based on the prior art. Accordingly, reversal of the rejections of claims 16 and 17 is similarly requested.

⁶ For a more detailed discussion of claim interpretation, see *supra* at 13-14.

⁷ See Specification: page 7, last paragraph, continuing on page 8.

Claims 18-19

Claims 18 and 19 recite as follows:

18. The portable light of claim 16, wherein the second housing meets UL standard 1310.
19. The portable light of claim 16, wherein the second housing meets UL standard 94 V1.

The Action argues that Werner discloses all limitations of claims 18 and 19, except the second housing meeting the UL standard 1310 or UL standard 94 V1. The Action further argues that it would have been obvious to one of ordinary skill in the art at the time of the invention to have the second housing satisfy the requirements of UL Standard 1310 or UL Standard 94 V1, “since satisfying the operational and/or regulatory requirements of a particular application would have flown naturally to one of ordinary skill in the art.”

Claims 18 and 19 are dependent indirectly on claim 15. As previously discussed in *supra* at 13-15, Werner does not teach a second housing according to claim 14. Therefore, for at least the same reasons previously presented, the Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, the rejection of claims 18 and 19 is traversed.

Even assuming, *arguendo*, that Werner did disclose every element of claims 18 and 19 except the second housing meeting the UL standards, there is no motivation or suggestion in Werner or the prior art, at the time of the invention, to modify the second housing of Werner to satisfy the UL standards. As previously discussed, configuring the second housing of the present invention to meet the UL standards avoids having to rate the entire lantern or light source in order for UL certification. According to embodiments of the present invention, the second housing which includes the AC-to-DC circuitry can be rated by the UL without the need for the rest of the lantern or light source to meet the standards. This feature is distinct from the teachings of the prior art and would not have flown naturally to one of ordinary skill in the art. Indeed, the transformer 80 and rectifier unit 81 of Werner, which together constitutes the AC-to-DC converter, are not removable and cannot be rated by the Underwriters Laboratories independently from the rest of the flashlight. In order for a flashlight according to Werner to meet the UL standards, the entire flashlight would have to be examined and rated by the Underwriters Laboratories. Therefore, there was no suggestion or motivation in the Werner or the prior art, at the time of the invention, to create a second housing in Werner that would meet the UL standards 1310 or the UL standard 94 V1. The

Examiner's conclusion only arises in hindsight from reading the Applicant's disclosure. Accordingly, reversal of the rejections of claims 18 and 19 is respectfully requested.

Claims 28-29

Claims 28 and 29 recite similar features as claims 18 and 19, respectively, except that they are dependent on claim 25. As previously discussed in *supra* at 10-14, Werner does not teach a second housing according to claim 25. Therefore, for at least the same reasons previously presented, the Action fails to establish a *prima facie* case of obviousness because the prior art does not disclose each and every element of claims 28 and 29. Also, for the reasons discussed in *supra* at 17-18 (discussion of claims 18-19), even if Werner did disclose all elements of claim 25, there is no motivation or suggestion in the prior art to modify the second housing of Werner to satisfy the UL standards. Accordingly, reversal of the rejections of claims 28 and 29 is respectfully requested.

D. The Rejection of Claims 20-22, 30 and 33-36 Under 35 U.S.C. § 103(a)

The Office Action rejects claims 20-22, 30 and 33-36 under 35 U.S.C. § 103(a)⁸ as being unpatentable over U.S. Patent No. 2,628,339 to Werner ("Werner") in view of U.S. Patent No. 6,260,985 to Zeller ("Zeller"). The Applicant respectfully traverses the rejections, and hereby appeals the same.

The Action argues that Werner individually discloses, or suggests, all the limitations of claims 20-22, 30 and 33-36, except the handle being pivotably coupled to the first housing (as recited in claim 20 and 30), such handle being pivotable between a raised position and a lowered position (as recited in claim 22 and 30). The Action states, however, that these features are disclosed by Zeller. The Action further states that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the pivotable handle of Zeller to the illumination device of Werner.

Claims 20-22 are dependent, directly or indirectly, on independent claim 14. As previously discussed in *supra* at 14-17 (discussion of claims 14 and 16-17), Werner fails to disclose a "second housing being substantially enclosed by the first housing", as recited in claim 14. Accordingly, neither Werner nor its combination with Zeller teaches each and every element of claims 20-22. For at least this reason, the Applicant respectfully submits

⁸ Claims 20-22 are rejected on pages 7-9 of the Office Action and claims 30 and 33-36 are rejected on page 9-12 of the Office Action.

that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established.

Claims 30 and 33-36 are dependent, directly or indirectly, on independent claim 25. As previously discussed in *supra* at 10-14 (discussion of claims 25 and 27), Werner fails to disclose “an AC-to-DC adapter including a second housing containing converter circuitry ... substantially enclosed by the first housing”, as recited in claim 25. Accordingly, neither Werner nor its combination with Zeller teaches each and every element of claims 30 and 33-36. For at least this reason, it is respectfully submitted that the Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Reversal of these rejections is requested.

E. The Rejection of Claims 31 and 32 Under 35 U.S.C. § 103(a)

The Office Action rejects claims 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,628,339 to Werner (“Werner”) in view of U.S. Patent No. 6,260,985 to Zeller (“Zeller”), further in view of U.S. Patent No. 6,789,924 to Yuen (“Yuen”). The Applicant respectfully traverses the rejections, and hereby appeals the same.

The Action argues that Werner and Zeller disclose individually, or suggest in combination, all the limitations of claims 31 and 32, except a lock (as recited in claim 31), being configured to lock the handle in at least one of the raised and lowered positions (as recited in claim 31) and the lock having a spring lock mechanism (as recited in claim 32). The Action states, however, that these features are disclosed by Yuen. The Action further states that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the locking mechanism of Yuen to the illumination device of Werner and Zeller to be able to lock the handle in a desired position.

Claims 31 and 32 are indirectly dependent on independent claim 25. As previously discussed in *supra* at 10-14 (discussion of claims 25 and 27), Werner fails to disclose “an AC-to-DC adapter including a second housing containing converter circuitry ... substantially enclosed by the first housing”, as recited in claim 25. Accordingly, the combination of Werner, Zeller, and Yuen fails to teach each and every element of claims 31 and 32. For at least this reason, it is respectfully submitted that the Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Reversal of these rejections is requested.

VIII. CONCLUSION

In view of the foregoing arguments, the Applicant respectfully requests reversal of the Examiner's rejection of claim 34 under 35 U.S.C. § 112, second paragraph. The Applicant also requests reversal of the Examiner's rejections of claims 25 and 27 under 35 U.S.C. § 102(b) as anticipated by Werner. The Applicant further requests reversal of the Examiner's rejections of claims 14, 16-19, 28-29 as unpatentable under 35 U.S.C. § 103(a) over Werner. The Applicant also respectfully requests reversal of the Examiner's rejection of claims 20-22, 30 and 33-36 as unpatentable under 35 U.S.C. § 103(a) over Werner in view of Zeller. The Applicant finally requests reversal of the Examiner's rejection of claims 31-32 as unpatentable under 35 U.S.C. § 103(a) over Werner in view of Zeller, and further in view of Yuen.

Respectfully submitted,

Date:

1/17/06


Jeffri Kaminski
Registration No. 42,709
Robert Kinberg
Registration No. 26,924
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Fax: (202) 344-8300

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IX. CLAIMS APPENDIX - 37 C.F.R. § 41.37(c)(1)(viii)

Appealed Claims:

14. A portable rechargeable electric light comprising:
 - a first housing;
 - a rechargeable power supply disposed in said first housing;
 - a light source coupled to said rechargeable power supply; and
 - an AC-to-DC converter disposed within a second housing and being coupled to the rechargeable power supply, the AC-to-DC converter including an AC connector arranged for being connected to an external power cord for delivering AC power to the AC-to-DC converter for recharging the rechargeable power supply and the second housing being substantially enclosed by the first housing.
16. The portable light of claim 14, wherein the AC connector comprises prongs extending from the second housing.
17. The portable light of claim 14, wherein the AC-to-DC converter circuit and prongs comprises a wall cube.
18. The portable light of claim 16, wherein the second housing meets UL standard 1310.
19. The portable light of claim 16, wherein the second housing meets UL standard 94 V1.
20. The portable light of claim 14, further comprising a handle having a first end and a second end, the second end being pivotably coupled to the first housing.
21. The portable light of claim 20, wherein the light source is disposed on the handle.

22. The portable light of claim 21, wherein the handle with said light source are pivotable between a raised position and a lowered position relative to the first housing.

25. A rechargeable light source, comprising:

a first housing defining a cavity therein;

a rechargeable power supply disposed in the cavity;

a light source selectively coupled to the rechargeable power supply; and

an AC-to-DC adapter including a second housing containing converter circuitry, the AC-to-DC adapter being arranged within the cavity such that the second housing is substantially enclosed by the first housing.

27. The light source of claim 25, wherein the AC-to-DC adapter comprises a wall cube.

28. The light source of claim 25, wherein the second housing meets UL standard 1310.

29. The light source of claim 25, wherein the second housing meets UL standard 94 V1.

30. The light source of claim 25, further comprising:

a handle having a first end and a second end; and

a pivot coupling joining said second end of handle to said housing so that the handle can be pivoted between at least one raised position and a lowered position relative to the first housing.

31. The light source of claim 30, wherein the pivot coupling further comprises a

lock, the lock being configured to lock the handle in the at least one raised position and in the lowered position.

32. The light source of claim 31, wherein the lock comprises a spring lock pressure mechanism.

33. The light source of claim 30, wherein the light source is disposed on the handle.

34. The light source of claim 25, further comprising a second light source disposed on the first housing.

35. The light source of claim 30, further comprising a switch arranged on the handle, the switch making and breaking a connection between the light source and the power supply.

36. The light source of claim 35, further comprising a locking mechanism disposed on the handle, the locking mechanism for being actuated by a user to interact with the switch to lock the switch in an on position.

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X. EVIDENCE APPENDIX - 37 C.F.R. § 41.37(c)(1)(ix)

NONE

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XI. RELATED PROCEEDINGS APPENDIX - 37 C.F.R. § 41.37(c)(1)(x)

NONE